

DOCKET NO. 9600000
TRADEMARK C-152C1 (STMI01-00043)
Customer No. 30425

PATENT

2814
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Danielle A. Thomas
Serial No. : 10/059,982
Filed : January 29, 2002
For : SCRATCH PROTECTION FOR DIRECT CONTACT
SENSORS
Group No. : 2814
Examiner : H.B. Trinh

RECEIVED

DEC 17 REC'D

TC 2800

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 C.F.R. § 1.144

Pursuant to 37 C.F.R. § 1.144, Applicant respectfully petitions from the Restriction Requirement mailed December 3, 2002.

Applicant traversed the Restriction Requirement in a response filed June 21, 2004, requesting reconsideration of the requirement.

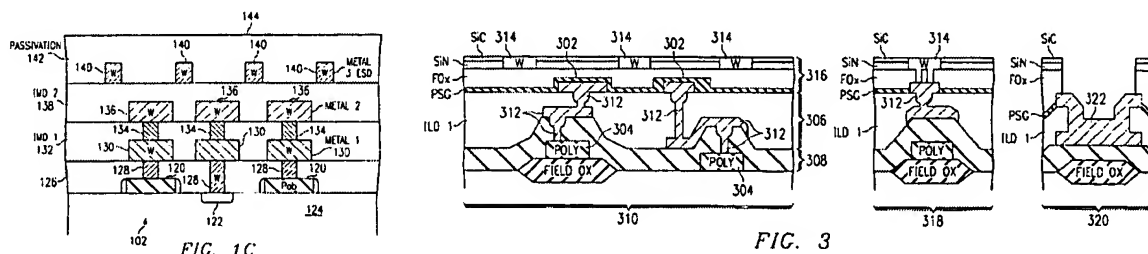
Every requirement to restrict has two necessary elements: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections. MPEP § 808, p. 800-47 (8th ed. rev. 1, February 2003).

The Restriction Requirement fails to state any reasons why the inventions are either independent of distinct, but instead merely asserts in conclusory fashion that the inventions are patentably distinct. In response to the request for reconsideration, the requirement was made final with the explanation:

The traversal is on the ground(s) that the examiner merely stated that the species are distinct. This is not found persuasive because Species I and Species II, as shown in the drawings particularly fig. 1C and fig. 3, are different and distinct from one another.

Paper No. 10, page 2. Thus, no explanation of what patentable differences are relied upon as the basis for requiring restriction has been made.

In addition, Applicant indicated in response to the requirement that all pending claims (claims 1–9 and 22–27) read on the provisionally elected species (species I, depicted in Figure 1C). Figures 1C and 3 differ in that Figure 3 shows, for the purposes of comparison, how ESD lines in pad and periphery regions may be connected to underlying circuitry, as opposed to ESD lines in sensing regions:



Both figures depict ESD protection lines 140, 314, within the protection/passivation layer 142, 316 overlying the sensing electrodes.

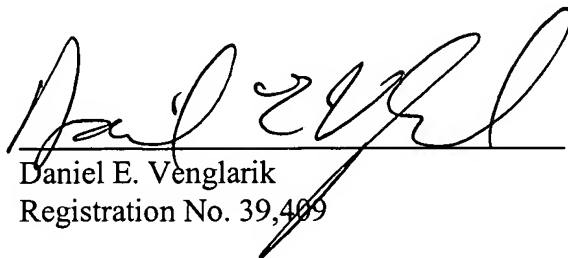
None of the independent claims (claims 1, 9 and 22) include limitations directed to ESD protection—in fact, recitation of ESD protection is ONLY found in dependent claim 23, and in no other pending claim. In particular, none of the pending claims are directed toward connection of the ESD lines to underlying circuitry within the pad and/or periphery regions of the integrated circuit. Nonetheless, the Examiner arbitrarily and capriciously selected and examined only claims 1–8, 14–21 and 24–27, without offering any explanation as to why claims 9 and 22–23 do not read upon the structure depicted in Figure 1C. Accordingly, withdrawal of the restriction requirement is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 12-6-04


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CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Sir:

The undersigned hereby certifies that the following documents:

1. Petition Under 37 C.F.R. §1.144; and
2. postcard receipt;

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 6, 2004.

Date: 12/6/04

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